

First Named Inventor	Andrew L. DiRienzo	PRE-APPEAL BRIEF REQUEST FOR REVIEW
Serial No.	09/961,308	
Filing Date	September 25, 2001	
Group Art Unit	2178	
Examiner Name	Kristina B. Honeycutt	
Confirmation No.	8424	
Attorney Docket No.	236.002US08	
Title: ATTACHMENT INTEGRATED CLAIMS SYSTEM AND OPERATING METHOD THEREFOR		

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In response to the Final Office Action mailed March 28, 2006, please consider the following in the Pre-Appeal Brief Request for Review:

REMARKS*Claim Rejections Under 35 U.S.C. § 112*

Claims 51, 62, 68, 90 and 97 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. Applicant respectfully traverses.

The Office Action contends that the limitation “the field associated with that label” of claim 51 lacks antecedent basis. Office Action, page 3, section 5. Applicant contends that antecedent basis is found within claim 51 itself. Claim 51 recites, in part, “wherein each of the N fields has an associated label identifying specific information to be inserted into the field associated with that label.” Applicant contends that it is clear from the context of the claim that “that label” refers to the label identifying specific information that is associated with a field of interest where data is being inserted.

The Office Action contends that the limitation “said ability” of claim 62 lacks antecedent basis. Office Action, page 3, section 5. Applicant contends that antecedent basis is found in claim 60, from which claim 62 depends. The Applicant contends that the limitation “said ability to directly integrate the transmitted file into the information system of the selected one of the M recipients” in claim 62 has sufficient antecedent basis as claim 60 recites that the transmittable file generated can be digitally integrated directly into an information system of the selected one of the M recipients.

The Office Action contends that the limitation “the Internet” of claims 68 and 97 lacks antecedent basis. Office Action, page 3, section 5. Applicant contends that the limitation “the Internet” in claims 68 and 97 has sufficient antecedent basis as it is a proper noun and it would be improper for it to be preceded by the article “a” or “an.”

The Office Action contends that the limitation “the members” of claim 90 lacks antecedent basis. Office Action, page 3, section 5. Applicant contends that the limitation “the members of the active subset” in claim 90 has sufficient antecedent basis in that it is inherent that a subset contain members. MPEP § 2173.05(e) acknowledges that inherent components of elements recited have antecedent basis in the recitation of the components themselves.

In view of the foregoing arguments, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, and allowance of claims 51, 62, 68, 90 and 97.

Claim Rejections Under 35 U.S.C. § 101

Claims 47-99 were rejected under 35 U.S.C. § 101 because the claimed invention is asserted to be directed to non-statutory subject matter. Specifically, the Office Action asserted, “The language of claims 47-99 raises a question as to whether the claimed graphical user interfaces are directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. § 101.” Office Action, page 3, section 6. Applicant respectfully traverses.

Applicant contends that each of the independent claims 47, 52, 88 and 90 are statutory subject matter as each GUI is responsive to entered data to cause a functional change in a computer, e.g., selecting a format of the generated file or selecting what fields will accept further data entry. Applicant contends that such a transformation is concrete, useful and tangible and is thus statutory subject matter under 35 U.S.C. § 101. Applicant thus respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 101, and allowance of claims 47-99.

Claim Rejections Under 35 U.S.C. § 102/103

Claims 47-54, 64-66, 72-75, 88-92, 94-96 and 98 were rejected under 35 U.S.C. § 102(e) as being anticipated by Guzik et al. (U.S. Patent No. 6,055,333). Claims 55, 56 and 59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Rossmann (U.S. Patent No. 6,625,447). Claims 57 and 58 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Cauffman et al. (U.S. Patent No. 5,325,290). Claims 60-63, 68-71, 93 and 97 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Loveria, III (U.S. Pub. No. 20040090466). Claim 67 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Aldrich et al. (U.S. Patent 5,138,698). Claims 76-80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over

Guzik et al. in view of Goltra (U.S. Patent 5,802,495). Claims 81-86 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Laszlo (U.S. Patent 5,331,547). Claims 87 and 99 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Guzik et al. in view of Rossmann in further view of Loveria. Applicant respectfully traverses as to each of these rejections.

Applicant contends that each of the rejections relies on a mischaracterization of the primary reference of Guzik et al. as applied in the Office Action. In particular, the Office Action states, “In other words, Guzik teaches entering data into fields which determines the fields that are capable of accepting data. Since the amended claim states that *at least one* of the file format and a subset of the N fields are determined in response to data entered, Guzik teaches this limitation.” Office Action, page 23, section 16 (emphasis in original). However, Applicant contends that entering data into a field in Guzik et al. only verifies that that particular field is having data entered into it. *See, e.g.*, Guzik et al., column 4, lines 15-17. Guzik et al. does not teach or suggest determining what subset of the other fields will be capable of accepting data in response to filling in that one field. In the instant claims, this subset of fields capable of accepting data is determined by a logical response of a computer system to the specific data entered into one field. The fields of the form not contained in this subset would not be able to accept data, since they would, for example, be write protected. The logical response to different data entered into that one field may be a different subset of the other fields being capable of accepting data. As an example, claims 47 and 52 recite, in part, “at least one of a file format of the file and a subset of the N fields that will be data-accepting fields is determined responsive to data entered into a first predetermined one of the N fields.” As Guzik et al. does not determine a file format of a generated file in response to data entered into a field and does not determine what subset of its fields will be data-accepting fields in response to data entered into one field, the cited reference cannot teach or suggest at least this element of claims 47 and 52. Because each of the rejections relies on similar rationale using this mischaracterization of the Guzik et al. reference, Applicant contends that the Office has not properly supported rejection of any of the claims under 35 U.S.C. § 102 or 35 U.S.C. § 103. For further detail on the specific argument in support of each independent claim, please see Applicant’s detailed response to the individual rejections as presented in its January 11, 2006 response.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103, and allowance of claims 47-99.


CONCLUSION

In view of the above remarks, Appellant believes that all pending claims are in condition for allowance and respectfully requests a Notice of Allowance be issued in this case. Please charge any further fees deemed necessary or credit any overpayment to Deposit Account No. 501373.

If the Examiner or the review panel has any questions or concerns regarding this application or request, please contact the undersigned at (612) 312-2204.

Respectfully submitted,

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